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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,870	10/21/2005	Satoru Nishiuma	03500.103115.	1107

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

WEISZ, DAVID G

ART UNIT	PAPER NUMBER
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4153

MAIL DATE	DELIVERY MODE
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10/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,870	Applicant(s) NISHIUMA, SATORU	
	Examiner DAVID WEISZ	Art Unit 4153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20070129; 20051021</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Danielzik et al. (US 5,822,472).

Regarding claim 1, Danielzik et al. discloses, in Figure 1, an optical analysis device (1) comprising:

a light-transmitting member (4) for transmitting light (k_{ie}), having an external face capable of immobilizing a detection-objective substance (see “substances having luminescence properties immobilized on the layer (b)” Col3/lines 26-50);

a light separating means (3) for separating an exciting light (see “luminescence” Col3/Lines26-50) introduced into the light-transmitting member at a first end (Figure 1) thereof and transmitted through the light-transmitting member (4), and fluorescence light (see k'_{out} Col3/Lines26-50 and “luminescence is fluorescence”, Col10/Lines14-19) produced by the excitation of the detection-objective substance by the exciting light (see “luminescence produced by substances” Col6/Lines26-50), at a second end of the light-transmitting member (Figure 1), and

a detecting means (see “detection system” Col5/Lines26-33) for detecting the fluorescence light (see “luminescence radiation” Col5/Lines26-33) separated by the light separating means (3).

Regarding claim 2, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the light-separating means is a diffraction grating (see "coupling grating" Col3/Lines26-50 or (3) in Figure 1).

Regarding claim 3, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the light-transmitting member comprises an optical waveguide (see "waveguiding layer", Col3/Lines26-50 or (4) in Figure 1).

Regarding claim 4, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the optical analysis device comprises a flow path (see “flow” col16/lines1-5) which covers the light-transmitting member (4) and has an inlet (2) for introducing the detection-objective substance and an outlet (3) for discharging the detection-objective substance (see also Col3/Lines33-36).

Inherently, a flowing substance introduced into a system needs an inlet and an outlet.

Regarding claim 5, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the light-transmitting member (1) has at the first end thereof a coupling means (2) for coupling exciting light (see (k_{ie})“coupling the excitation light” Col3/lines26-50) to the light-transmitting member (4).

Regarding claim 6, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the coupling means is a diffraction grating “see coupling grating” col6/lines5-10).

Regarding claim 7, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the external face (see “surface” col11/lines5-10) of the light-transmitting (1) member is capable of immobilizing (see “immobilising” col11/lines5-10) a trapping component (see “adhesion-promoting layer” col11/lines24-33) for trapping the detection-objective substance (see “detector substances” col11/lines24-33).

Regarding claim 8, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the trapping component (see “adhesion-promoting layer” col11/lines24-33) traps the detection-objective substance by an antigen-antibody reaction (see “antibodies for antigens” Col11/lines34-42).

Regarding claim 9, Danielzik et al. discloses all the claim limitations as set forth above. Additionally, the reference discloses that the trapping component (see “adhesion-promoting layer” col11/lines24-33) traps the detection-objective substance by hybridization reaction of DNA (see “hybridization assays with DNA” Col10/Lines35-40).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID WEISZ whose telephone number is (571)270-7073. The examiner can normally be reached on Monday - Thursday, 7:30 a.m. - 5:00 p.m., EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Basia Ridley can be reached on (571)-272-1453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. W./
Examiner, Art Unit 4153

/Basia Ridley/
Supervisory Patent Examiner, Art Unit 4153